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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,288	08/01/2003	Charles L. Branch	MSDI-261/PC750.00	3338
52196 7590 01/09/2009 KRIEG DEVAULT LLP ONE INDIANA SQUARE, SUITE 2800 INDIANAPOLIS, IN 46204-2709				
EXAMINER				
RAMANA, ANURADHA				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
01/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/633,288

Applicant(s)

BRANCH ET AL.

Examiner

Anu Ramana

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29, 31-40, 42-49 and 55-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 31-40, 42-49 and 55-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25, 35, 45, 49, 56 and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the functional recitation "so that when bent and positioned along said inner wall surface said at least one wall member returns toward said pre-bent configuration and frictionally engages said inner wall surface" renders the claim vague and indefinite because "said pre-bent configuration" lacks antecedent basis. It is suggested that alternate claim language, consistent with Applicant's disclosure at page 2 of Applicant's specification be used. For e.g., "the wall member being deformable to assume any one of a number of configurations for positioning of the wall member in the working channel such that the wall member frictionally engages said inner wall surface."

Additionally, in claims 15, 25, 35, 45 and 49, the recitation "with said inner surface of said retractor extending completely around said tube to define said working channel" renders the claim vague and indefinite because the structural relationship between the inner surface, the working channel and the tube defining the retractor is not clearly recited. It is suggested that alternate claim language be used, for e.g., the inner surface of the tube defining the working channel.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-7, 9-14, 16, 19-20, 22-24, 26, 29, 31-34, 36, 39-40, 42-49, 55, 57, 58 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Florin (US 3,626,471).

Florin discloses a retractor with an inner wall surface defining a working channel therealong and a fiber optic element or lighting element 21 with resilient or bendable wall members (22, 23) engageable with the inner wall surface (Figs. 1, 2, col. 1, lines 21-47 and col. 2, lines 1-23). Each wall member extends along the width of the inner wall surface (Figs. 2 and 3). Further, each wall member has a convexly curved surface and a concavely curved wall surface opposite the convexly curved surface.

Claims 36 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilder et al. (US 4,562,832).

Wilder et al. disclose a retractor 42 including a working channel and a resinous core or lighting element including at least one wall member or portion, i.e., the light pipe 44, wherein the wall member is positionable and circumferentially movable along the inner wall surface by being received in openings 43 that penetrate the inner wall surface (Fig. 7 and col. 9, lines 22-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 17-18, 27-28, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin (US 3,626,471) in view of Lail (US 6,621,966).

Florin discloses all elements of the claimed invention except for the fiber optic element being a group of optical fibers.

Fiber optic elements provided as groups of optical fibers are well known as evidenced by Lail (Fig. 6).

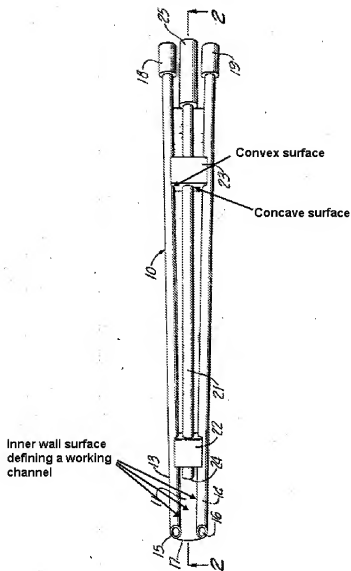
The substitution of one known fiber optic element (cable with a plurality of fibers as disclosed by Lail) for another known fiber optic element (as disclosed by Florin) would have been obvious to one of ordinary skill in the art at the time the invention was made because this amounts to simple substitution of one known fiber optic element for another and would have yielded predictable results, namely, illumination at a desired location.

Response to Arguments

Applicant's arguments filed on September 10, 2008 have been fully considered.

Applicant's arguments with respect to the rejections over Florin are not persuasive because, the clips or wall members (22, 23) are inherently resilient, otherwise, they would not work for their intended purpose, namely holding the lighting element, in position, on an inner wall surface of the retractor. Marked up Fig. 1 from Florin is provided on the following page, to clarify the examiner's interpretation of Florin.

Regarding the rejections of claims 36 and 42 over Wilder et al., the examiner notes that light pipe 44 is positionable and circumferentially movable along the inner wall surface of retractor 42. It is noted that inner and outer surfaces are relative and are based on the point or axis chosen as the reference.



Allowable Subject Matter

Claims 15, 25 and 35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
January 5, 2009

/Anu Ramana/
Primary Examiner, Art Unit 3775